



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/849,195
Applicant : GUTTAG ET AL.
Filed : MAY 20, 2004
Title : DIGITAL BACKPLANE

Art Unit : 2673
Examiner : DHARIA, P.

Atty Docket No. : KAGU-0002-UT1

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In conjunction with the Notice of Appeal concurrently filed for the above application involving Claims 1-15 on appeal, Applicants respectfully request a pre-appeal review further to the Official Gazette Notice of July 12, 2005 which authorizes Pre-Appeal Brief Conferences.

I. Basis for Request for Review.

This request is necessitated by the failure of Final Action of August 4, 2005 (Final Action) to: (1) comply with 37 CFR 104(c)(2) in specifying the basis for the rejections recited in the Final Action; (2) comply with 37 CFR 104(d)(2) in providing, when properly requested by Applicants, affidavits/declarations to support facts within the personal knowledge of the Examiner in support of these rejections; (3) articulate a proper basis for the "motivation to combine" the various references relied on for these rejections; and (4) to use the definitions of terms defined in Applicants' specification. This request is also necessitated by: (5) the Final Action making statements and taking positions that are contrary to known scientific facts. There are also numerous grammatical errors in this Final Action that make it not only difficult to understand, but difficult for Applicants to respond to the Final Action. The Final Action has also cited, for the first time during the prosecution of this application, a new reference "Webster". However, the Final Action never fully identifies this reference, never provides a copy of any portion thereof, never cites any text thereof, and provides an interpretation thereof that appears to be based on the personal knowledge of the Examiner.

A. Failure to Comply with Requirements of 37 CFR 104(c)(2).

The Final Action repeatedly refers to “Webster [sic]” as defining certain terms or words, but fails to specify which “Webster” is being referred to, which portions (*e.g.*, page) of “Webster” is being referred to, which definition (*e.g.*, “matrix”) of “Webster” is being referred to, or even why the particular “Webster” is being referred to versus any other “Webster”. See pages 2, 5, 7, 13, 15 of the Final Action. Nor does the Final Action provide any of the portions of “Webster” being used. Instead, Applicants are forced to improperly guess what “Webster”, or portion thereof, *etc.*, is the basis for the rejections in the Final Action. Therefore, all of the rejections in the present application are rejections based on a “phantom reference”, Webster.

In numerous instances the Final Action cites column and line numbers and drawing figures without specifically identifying a particular element of the cited references that the Examiner believes is equivalent to a feature of the claimed invention. In fact, the Final Action only identifies one element (item 96 of Schaffer et al.). Also, the Final Action never quotes specific text of any of the cited references or explains how the references teach that the various cited sections of the references are connected to each other. In their May 19, 2005 Amendment, Applicants pointed out these deficiencies in the Office Action dated April 28, 2005 (See Section A, pp. 28-29; and Section B, pp. 31-34); however, the Examiner has refused to remedy these deficiencies in the Final Action. Instead, the Final Action again forces Applicants to improperly guess the basis for the rejections in the Final Action. One omission of the type noted above would make the Final Action *prima facie* improper. But the large number of these omissions in the Final Action plainly establishes a gross violation of 37 CFR 1.104(c)(2).

In addition, the grammatical errors in the Final Action are so numerous and confusing in so many instances as to violate the requirement of 37 CFR 1.104(c)(2) that the “pertinence . . . of each reference be *clearly explained* (emphasis added).” The Response to Arguments section at pages 10-19 of the Final Action is a particularly egregious example of this problem.

B. Failure to Comply with Requirements of 37 CFR 104(d)(2).

In the first Office Action of April 28, 2005 (April 28 Office Action), the Examiner made numerous unsupported statements having no basis in the references relied on for the rejections. In their response to this April 28 Office Action (see Applicant’s May 19, 2005 Amendment, Section D, pp. 38-43), Applicants properly requested the Examiner to supply affidavits/declarations under 37 CFR 1.104(d)(2) in support of those statements. So far, the Examiner has not only failed to supply these properly requested affidavits/declarations under 37 CFR 1.104(d)(2), but has also failed to adequately explain why 37 CFR 1.104(d)(2) does not apply to these unsupported statements. Instead, page 19 of the Final Action improperly suggests that Applicants look at the “search notes, on which examiner lists all the people accessed and discussed the prior art teaching is also part of the correspondence and is accessible on the PAIR system.” In fact, the statements on page 19 of the Final Action are an admission that the Examiner has relied on his own personal knowledge and not on

reference cited in the Final Action. In addition, during a Telephone Interview with Applicants' counsel on August 9, 2005, Examiner Shalwala (the Examiner who signed the Final Action) stated that he was free to ignore Applicants' request under 37 CFR 1.104(d)(2) with respect to Claims 1-14. The above-described gross violations of 37 CFR 1.104(d)(2) should result in: (1) all rejections in the Final Action being withdrawn, and (2) pending Claims 1-15 being deemed in condition for allowance.

C. Failure to Articulate a Proper Basis for "Motivation to Combine" References.

The Final Action repeatedly combines the teachings of the cited references Yumoto et al., Scheffer et al., and Van Dijk using inadequate and conclusory statements that the teachings of these references can be combined. The rejection of Claims 1-4 in section 3 of the Final Action (pp. 2-3) is a representative and egregious example of this problem. Nowhere does the Final: (1) provide a proper basis for combining the teachings of these references; (2) articulate any proper "motivation to combine" these references; (3) explain where the "motivation to combine" can be found in the references or elsewhere in the art; or (4) explain what standard (*e.g.*, based on the case law or MPEP) is being relied on for the "motivation to combine" the references. Applicants pointed out the Examiner's failure to provide any proper "motivation to combine" the cited references in Applicants' May 19, 2005 Amendment (see Section A, pp. 25-26 and Section B, p. 30). Instead, the Final Action never properly responds to Applicants' comments on the Examiner's failure to provide proper motivation in the April 28 Office Action. In fact, the Final Action never even refers to "motivation to combine" when the teachings of these references are combined together.

The Examiner admits that "The claimed limitations of Claims 1-4 are not cluttered [sic] together in one small paragraph in cited [sic] references", but alleges that "all cited columns, figures and line numbers do adequately teach applicant's [sic] claimed limitation [sic]". In fact, the features of Claims 1-15 are not only not clustered together in one paragraph of the cited references, but the cited sections of the cited references are improperly tied together for reasons known only to the Examiner and not found anywhere in the cited references. A mere collection of unconnected column numbers, figure numbers and line numbers by themselves do not "teach" anything, much less teach or suggest the claimed invention. The Examiner has only provided Applicants with a confusing jumble of seemingly random citations of marginal relevancy to the claimed invention. The Examiner has not shown, through cited text and/or elements in the figures of these references, how the claimed invention is taught or suggested by the combination of these references, or even why these references may be combined.

D. Improperly Ignoring Applicants' Definitions of Terms

In the Final Action, the Examiner repeatedly uses the reference "Webster" instead of the Applicants' specification to define various terms. The Examiner states that "The interpretation of the claim limitations are given broadest [sic] meaning as per MPEP using applicant's [sic] specification as well as Webster [sic] dictionary and using those interpretation [sic] prior arts [sic] are search to reject applicant's [sic] claimed limitations" (See Final Action, p. 19). By contrast, MPEP §

2106(II)(C) says, "Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings.>")." Unfortunately and contrary to this section of the MPEP, the Examiner has never referred to any definition in Applicants' specification in making any rejection during the prosecution of the present application. In fact, the only portions of Applicants' specification that have been cited in any of the four Office Actions are the claims.

In addition, the Examiner has felt free to ignore Applicants' definitions of various terms in the specification in favor of the definitions found in the "phantom reference" Webster. For example, the Final Action looks to Webster for definitions of the terms "explicit recursive feedback" and "implicit recursive feedback" (see Final Action, p. 16), while ignoring that the specification defines "implicit recursive feedback" (see published application, paragraphs 122 and 123) and "explicit recursive feedback" (see published application, paragraph 113). The Examiners repeated reliance on the "phantom reference" Webster, even when Applicants' specification defines these claim terms, is clearly improper in view of MPEP § 2106(II)(C). Applicant also notes that during a Telephone Interview with Applicants' counsel on August 9, 2005, Examiner Shalwala stated, incorrectly, that he believed that it was proper under MPEP § 2106 to refer to Webster and ignore Applicants' specification in determining the meaning of the terms "implicit recursive feedback" and "explicit recursive feedback", as well as any other terms in the claims. Because the rejections of Claims 1-15 are all based on the Examiner's improper definitions of the various claim terms and the Examiner's erroneous understanding of MPEP § 2106, all of the rejections in the Final Action are *prima facie* improper, and should be withdrawn.

E. Positions Contrary to Known Scientific Fact.

Applicants agree that Claim 15 is allowable but not for reasons stated in the Final Action. Claim 15 is allowable because Kang et al. (Kang) does not teach any indicating means, much less a "pH indicating means." Unfortunately, page 18 of the Final Action says that Kang teaches a "LCOS (Liquid Crystal on Silicon) with Ph indicator," thus incorrectly implying that "Ph" taught by Kang is the same or similar to "pH" defined in allowed Claim 15. As any skilled chemist would know, the suggestion by the Final Action that "Ph" taught by Kang and "pH" defined in allowed Claim 15 are the same, or in any way similar, is factually and scientifically wrong and absurd (see the discussion of this issue in Applicants' May 19, 2005 Amendment at Section C, pp. 34-37). The Final Action further compounds this absurdity by refusing to identify (other than by an improperly requesting Applicants to look it up in PAIR) *which* Examiner was consulted who allegedly said "Ph" taught by Kang was the same as "pH" as defined in Claim 15. The identity of this Examiner was properly requested by Applicants under 37 CFR 1.104(d)(2) in their May 19, 2005 Amendment (see pp. 42-43). Applicants

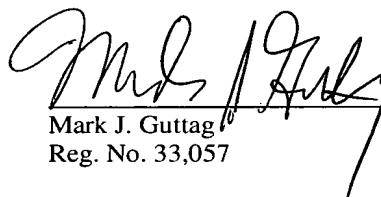
also note that the Examiner has never identified a single example of a "pH indicator" anywhere in Kang.

II. Relief Requested.

For reasons given above, the Final Action that was issued in the present application is grossly deficient and in violation of the Rules of Practice, especially 37 CFR 104(c)(2) and 104(d)(2), as well as the MPEP, including the rules relating to the meaning of claim terms. The failure of the Final Action to comply with 37 CFR 104(c)(2) makes the rejections of claims 1-14 *prima facie* improper. In addition, with a total disregard of the Rules of Practice, the Examiner has failed to provide properly requested affidavits/declarations under 37 CFR 1.104(d)(2). Because of the Examiner's failure to provide these affidavits/declarations, the rejection of these Claims must now be considered *prima facie* improper for this additional reason.

The rejections of Claims 1-14 are also *prima facie* improper because the Examiner has failed to provide proper motivation for combining the references. The rejections of Claims 1-14 are also *prima facie* improper because the Examiner has totally ignored the definitions of terms in Applicants' specification in favor of the Examiner's own definitions based on a phantom reference. Therefore, Applicants hereby request that all of the rejections be withdrawn and Claims 1-15 be allowed. In addition, Applicants request that the Examiner state that Claim 15 is allowable, because the Kang reference does not teach a pH indicator or any other type of indicator.

Respectfully submitted,


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